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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/913,401 | 01/16/2002 | Alfred Pollak | 7126-2 | 8318 |

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,401

Applicant(s)

POLLAK ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 33-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|--|

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of Applicant's request for reconsideration filed 6/13/06.

Note: Claims 1-31 and 33-49 are pending.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. The Applicant's request for reconsideration and arguments filed 6/13/06 was considered, but was not found persuasive for the following reasons.

103 Rejections

The rejection of claims 1-31 and 33-49 under 35 USC 103(a) as being unpatentable over Hoffman et al (US Patent No. 6,821,256) is MAINTAINED for reasons of record in the office action mailed 3/13/06 and those set forth below.

Applicant asserts that all the claim limitations are not met by the cited prior art. In particular, Applicant asserts that there must be some motivation/suggestion in the art to modify the teachings of the reference and there is no reasonable expectation of success. Specifically, asserts that the cited prior art does not disclose a conjugate which is releasably bound to the support surface and is released from the surface upon coordination with the metal ion and no metal support surface is disclosed.

Hoffman et al disclose gastrin receptor avid peptide conjugates that are useful for treating or diagnosing neoplastic diseases. In Figure 22, a complex is disclosed having a chelator, metal, linker moiety, and Applicant's SEQ ID No. 1 (QWAVGHLM). As a result, Hoffman et al disclose a composition and methods of generating such

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compositions comprising a chelator, targeting moiety, and metal support which as disclosed in Applicant's specification page 10, lines 1-12, may be a ligand that contains one accessory group and a surface binding group (in this instant, the ligand may be referred to as a 'chelator'). In addition, it is disclosed that the legends that contain two or more accessory groups and a surface binding group are referred to as multidentate and typically form more stable metal ligand complexes than do monodentate ligands. Applicant's specification further discloses that many ligands that bind to radionuclides metals are tetradentate containing a combination of four nitrogen and sulfur metal coordination atoms (i.e., N₃S and N₂S₂). Now, since Hoffman et al disclose that their metal complexing chelators can include monodentate and polydentate chelators. Also, Hoffman et al disclose that metal complexing chelators include tetradentate metal chelators which can be macrocyclic and have a combination of four nitrogen and/or sulfur metal cording atoms and are designated as N₄, S₄, N₃S, N₂S₂, NS₃, etc.). Hence, the skilled practitioner in the art would recognize that both Hoffman and Applicant disclose overlapping inventions.

Furthermore, Applicant is reminded that some of the claims are directed to a product and method of making a product comprising a metal support surface and a conjugate comprising a ligand and targeting molecule. The intended use of the product (for generating a complex forming metal label agent) and how and what occurs when the conjugate binds to the support surface carries no patentable weight for a product claim, but for a method claim wherein the utility is considered in combination with all method steps. Thus, the rejection is deemed proper since Hoffman et al renders

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obvious the instant invention for the reasons set forth above. Also, Applicant is reminded that if the components disclosed by Applicant are the same as those of the prior art then their properties would be expected to be the same because a product is inseparable from its properties. Thus, the product of the prior art would be expected to behave as Applicant's product (i.e., be releasably bound to the support surface).

COMMENTS/NOTES

3. Applicant's remarks regarding the restriction requirement are noted, but are not found persuasive for reasons already of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

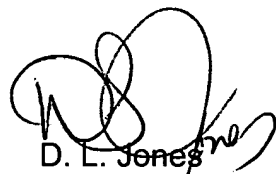
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

August 18, 2006